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DELIO & PETERSON 121 WHITNEY AVENUE NEW HAVEN, CT 06510			ALVAREZ, RAQUEL	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/583,516
Filing Date: May 31, 2000
Appellant(s): EMENS ET AL.

MAILED

JUL 28 2004

GROUP 3600

Leonard T. Guzman

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/4/2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because some of the claims have the same elements and therefore should be grouped together. The grouping should be as follows:

Claims 1, 3 and 22 stand and fall together.

Claims 2, 5 and 23 stand and fall together.

Claims 6 and 26 stand and fall together.

Claims 7-12 and 27-29 stand and fall together.

Claims 16, 18, 31 and 35-36 stand and fall together.

Claims 15 and 19 stand and fall together.

Claim 17 stand and fall by itself.

Claim 20 is similar to claims 9-12

Claim 25 stand and fall by itself.

Claims 32-34 stand and fall together.

Claims 13, 21 and 30 stand and fall together.

Claim 14 stand and fall by itself.

Claim 37 stand and fall by itself.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

WO 98/36366

Skillen

08-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2-3, 5-12, 15-20, 22-29, 31-36 rejected under 35 U.S.C. 102(b) as being anticipated by Skillen et al. (Wo 98/36366, hereinafter Skillen).

With respect to claims 1, 3, 22, Skillen teaches a method for targeting an associated advertisement from an Internet search having access to an information repository by a user (Abstract). Identifying at least one search result item from a search result of said Internet search by said user (i.e. a traditional keyword search in the Internet produces a search result and the associated keyword is used to match the keyword to a product data 24 of database 20)(page 7, lines 16-25); searching for said at least one associated advertisement within said repository using said at least one search result item (page 7, lines 16-25); identifying said associated advertisement from said repository having a word that matches said at least one search result item (page 7, lines 16-25); and correlating at least one said advertisement with said at least one search result item (page 7, lines 16-25).

With respect to claims 2, 5 and 23, Skillen further teaches providing the advertisement on demand by said user (page 8, lines 12-22).

With respect to claims 6 and 26, Skillen teaches designating user search result items matched to said associated advertisements for subsequent selection by user (page 7, lines 34-, page 8, lines 1-3).

With respect to claims 7-12, 27-29 Skillen further teaches submitting a query to said information repository and obtaining said individual search result items as an URL (page 7, lines 34, page 8, lines 1-3).

With respect to claims 16, 18, 31 and 35-36 Skillen teaches providing related advertisements for search result items from a search of an information repository (Abstract). A computer readable program code means for causing a computer to effect

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matching said result items to said related advertisements (page 7, lines 34-, page 8, lines 1-3); a computer readable program code means for causing a computer to effect designating each of said search result items that have said related advertisements matched therewith (page 7, lines 34-, page 8, lines 1-3); a computer readable program code means for causing a computer to effect providing a corresponding graphical user interface for each of said search result items so designated for subsequent selection by a user (i.e. the user can click on the search results); a computer readable program code means for causing a computer to effect searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by said user (page 7, lines 34-, page 8, lines 1-3); and a computer readable program code means for causing a computer to effect formatting and displaying said related advertisements upon selection (page 7, lines 34-, page 8, lines 1-3).

With respect to claim 15 and 19, Skillen further teaches that the user interface comprises a product icon (page 8, lines 12-22).

With respect to claim 17, Skillen further teaches assigning an identifier for said user when said user submits a query to said information repository (page 8, lines 12-22).

Claim 20 is similar in scope as claims 9-12 and therefore rejected under similar rationale.

With respect to claim 25, Skillen further teaches displaying along with said search result a user-selectable icon containing a link to said associated advertisement (page 6, lines 35-, page 7, lines 1-9).

With respect to claims 32-34, Skillen further teaches formulating a list of the related advertisements and passing the list to the request server (page 9, lines 9-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 21, 30 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen.

With respect to claim 13, 21 and 30, the claims further recite an off-line batch process for identifying said related advertisements for said search result items. Skillen teaches on page 8, lines 23-33 maintaining a database of the search results for the users in order to find the best fit product advertisement for the user. Skillen doesn't specifically teach that the process is conducted off-line. Official notice is taken that off-line processing is old and well known. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included processing the information off-line because such a modification would allow for the information to be analyzed at a later time.

Claim 14 further recites providing a true/false designator to a user indicating whether said related advertisements exist for said individual search results items. Since, Skillen teaches advertisements based on the individual search results items (see abstract and drawings) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing a true/false to the user if said related advertisements exist because such a modification would give the users a definite response that advertisements based on the search criteria used does or doesn't exist.

Claim 37 further recites assigning an identifier for said user when said query is submitted to said information repository. Official notice is taken that it is old and well known to assign identifiers in order to differentiate items or persons. For example, a user is given a social security number to identify a particular person. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the user's query submitted to said information repository of Skillen to assign an identifier because such a modification would provide the above mentioned advantage.

(11) Response to Argument

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the initial search argument is not at least one search result item) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

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F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if this limitation was to be present in the claims, Skillen teaches that the associate search engine 18 will further refine its logical tree strategy and selects the probable best fit product and generates an **advertisement** based on the specific **search result** (in Skillen page 7, lines 36-, col. 8, lines 1-22).

With respect to Appellant's arguments that Skillen does not teach "searching for said at least one associated advertisement within said repository using at least one search result item". The Examiner respectfully disagrees with Applicant because when an item is searched, the result of the search for that item will produce a result consisting of the item that was searched plus other information pertaining to that item (page 7, lines 16-25), the end user can further refine his or her search by clicking on a **displayed search result**, the specific search result will generate an **advertisement** that best fit the selected **specific search result** (page 7, lines 31-37 and page 8, lines 1-11).

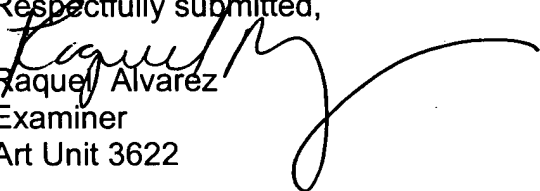
Appellant argues that Skillen does not teach a product matching manager means for analyzing said user sessions, said user queries, and said advertisements requests from said user/session manager and matching said associated advertisements from said use/session manager and matching said associated advertisements from said product database corresponding to each of said search result items. The Examiner disagrees with Appellant because as explained above Skillen teaches the end user searches for an item, the query is analyzed by the system and the user is presented with search results related to the item searched. **"In the case of the end user clicking on a specific search result, the associative search engine 18 further refines its**

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logical tree strategy and selects the probable best fit product and generates an advertisement" related to the search results (in Skillen page 7, lines 36-37 and page 7, lines 1-3).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Raquel Alvarez
Examiner
Art Unit 3622

July 23, 2004

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